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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,922	12/29/2000	Samuel Sergio Tenenbaum	033203-001	6803

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EXAMINER

HAMILTON, LALITA M

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/749,922

Applicant(s)

TENEMBAUM, SAMUEL SERGIO

Examiner

Lalita M Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to, because the use of the language "such as" and "for example" is improper. Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities: The grammar should be consistent throughout the specification. On p.1, there should be parentheses before "e.g." and after "credit cards". On p.2, there should be parentheses before "e.g." and after "serial number". On p.6-9, the use of the symbol before "112" should be deleted. On p.7, third paragraph, the comma between "only" and "or" should be deleted. On p.9, third paragraph, the semicolons after "or the like" should be replaced with commas, and "a cars" should be "a car". On p.11, second paragraph, the semicolon after "alcohol" should be deleted, and there should be parentheses before "e.g." and after "Santa Monica Blvd.". On p.12, "over the counter limits" should be

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"over-the-counter limits", and in the third paragraph, the word "or" should be between "yearly statements" and "overdraft statements". On p.13, second paragraph, there should be parentheses before "e.g." and after "22307", and in the third paragraph, there should be parentheses before "e.g." and after "2356". On p.14, second paragraph, there should be a comma after "institutions", and in the third paragraph, there should be parenthesis before "e.g." and after "papers".

Appropriate correction is required.

Claim Objections

Claim 22 is objected to because of the following informalities: The phrase "the password is a first password and the card bearer is a first card bearer and the password is a first password" is unclear. The Examiner recommends that the last portion, "and the password is a first password" be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added).

Claims 1-34 are rejected under 35 U.S.C. 101, because the claimed invention is directed to a non-statutory subject matter. Specifically the method claims as presented

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do not claim a technological basis in the pre-ambble and the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential].

In order to over come the 101 rejection above, the following preamble is suggested:

-A computer implemented method for ---, or something similar. Also, in the body of the claim include structural / functional interrelationship which can only be computer implemented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over White (WO 99/28850) in view of Blagg (US 2002/0198806).

Blagg discloses a system and corresponding method for linking a credit card to personal property comprising financing purchases using a Property Linked-credit Card associated with a specified property, establishing an agreement between a card issuer and a card holder under which the card issuer will pay a merchant for a purchase made by the card holder using the Property Linked-credit Card, the card holder will pay the card issuer for the purchase, and under which the card holder establishes a possessory authority over the specified property, issuing the Property Linked-credit Card to the card holder upon establishment of said agreement, and establishing an arrangement between the merchant and the card issuer under which the merchant charges the purchase made by the card holder against the card holder's Property Linked-credit Card and obtains payment for the purchase from the card issuer (p.3, beginning under the description to p.5, first paragraph); the card holder is the same legal entity as the card bearer (p.3, beginning under the description to p.5, first paragraph); the card issuer takes a security interest in said specified property for financing said purchase (p.3, beginning under the description to p.5, first paragraph); the property-linked credit card associated with a vehicle (p.3, beginning under the description to p.5, first paragraph—may be any type of personal property having value); establishing an agreement between a card issuer and a card holder under which the card issuer will pay a merchant for a purchase made by the card holder using the Property Linked-credit

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Card, and card holder will pay the card issuer for the purchase, and under which the card holder establishes a possessory authority over the vehicle; issuing the Property Linked-credit Card to the card holder upon establishment of said agreement, and establishing an arrangement between the card issuer and the merchant under which the merchant charges a purchase made by the card holder against the card holder's Property Linked-credit Card and obtains payment for the purchase from the card issuer (p.3, beginning under the description to p.5, first paragraph); establishing an agreement between a card issuer and a card holder under which the card issuer will pay a merchant for a purchase made by the card holder using the Property Linked-credit Card, and the card holder will pay the card issuer for the purchase, and under which the card holder establishes a possessory authority over the specified property, issuing the Property Linked-credit Card to the card holder upon establishment of said agreement, and establishing an arrangement between the merchant and the card issuer under which the merchant charges the purchase made by the card holder against the card holder's Property Linked-credit Card and obtains payment for the purchase from the card issuer (p.3, beginning under the description to p.5, first paragraph); presenting said Property Linked-credit Card to a merchant for a transaction to purchase goods or services and receiving the goods or services of the transaction after the merchant has performed verification (p.3, beginning under the description to p.5, first paragraph); establishing possessory authority comprises driving an automobile which is the specified property (p.3, beginning under the description to p.5, first paragraph—may be any type of personal property having value); establishing possessory authority over the

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specified property by the card bearer and presenting said Property Linked-credit Card to a merchant for a transaction to purchase goods or services (p.3, beginning under the description to p.5, first paragraph); collecting application information from an applicant; wherein the application information comprises information about the specified property, evaluating the application information, and issuing the Property Linked-credit Card associated with the specified property (p.3, beginning under the description to p.5, first paragraph); the specified property is real estate (p.3, beginning under the description to p.5, first paragraph); the specified property is an automobile (p.3, beginning under the description to p.5, first paragraph)—may be any type of personal property having value); and providing one or more physical copies of the Property Liaked-credit Card to the applicant (p.3, beginning under the description to p.5, first paragraph). White does not disclose limiting the delivery of the purchase to the specified property; the card holder is a different legal entity than the card bearer; the card holder prescribes a pre-selected password to authorize a purchase using the Property Linked-credit Card; the purchase is conditioned upon the card holder presenting the vehicle for inspection and/or verification by the merchant; specifying a password or other identifier and said merchant limits the use of the Property Linked-credit Card to a legal entity that delivers to said merchant the specified password or other identifier; the card holder establishes the legal entity to be any one of a plurality of authorized users with authorization to make purchases using the Property Linked-credit Card; each of the authorized users establishes a unique password, and use of the Property Linked-credit Card by said any one of a plurality of authorized users is conditioned upon tendering to said merchant the

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unique password or other identifier; the legal entity is restricted to conducting transactions in a predetermined geographic region; the legal entity is restricted to a predetermined spending limit; the legal entity is restricted to a predetermined spending limit for a given transaction type; the legal entity is restricted to using the Property Linked-credit Card for only a predetermined transaction type; allowing verification of the possessory authority by the card bearer over the associated property as a precondition for the transaction; receiving the goods or services in an automobile of the card bearer; the specified property is an e-mail address and the step of establishing possessory authority comprises communicating with the merchant from the e-mail address a password associated with the card bearer to the merchant; the password is a first password and the card bearer is a first card bearer and wherein a second card bearer has a second password for the Property Linked-Credit Card; the card bearer is restricted to conducting transactions in a predetermined geographic region; the card bearer is restricted to a predefined spending limit; specifying a password or other identifier; the merchant limiting the use of the property-linked credit card to a legal entity that delivers to the merchant the specified password or other identifier; the card bearer is restricted to a predefined spending limit for a given transaction type; the card bearer is restricted to conducting a given transaction type; the given transaction type is an Internet transaction; the given transaction type is a telephone transaction; providing a password associated with the card bearer to the merchant, wherein the password is a first password and the card bearer is a first card bearer, and wherein a second card bearer has a second password for the Property Linked-Credit Card, and arranging for

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delivery of the goods or services of the transaction to the specified property, wherein the first password is associated with a first predetermined limitation on the first card bearer's use of the Property Linked-credit Card, and the second password is associated with a second predetermined limitation on the second card bearer's use of the Property Linked-credit Card. Blagg teaches a method for accessing and modifying usage parameters associated with a financial account comprising limiting the delivery of the purchase to the specified property (p.1, 7 and p.2, 13; and p.3, 31-32--may set a parameter to limit delivery of the purchase to a specified property); card holder is a different legal entity than the card bearer (p.6, 58-61); the card holder prescribes a pre-selected password to authorize a purchase using the Property Linked-credit Card (p.12, 110); the purchase is conditioned upon the card holder presenting the vehicle for inspection and/or verification by the merchant (p.1, 7 and p.2, 13; and p.3, 31-32--may set as a parameter); specifying a password or other identifier and said merchant limits the use of the Property Linked-credit Card to a legal entity that delivers to said merchant the specified password or other identifier (p.12, 110); specifying a password or other identifier (p.12, 110); the merchant limiting the use of the property-linked credit card to a legal entity that delivers to the merchant the specified password or other identifier (p.1, 7; p.2, 13; and p.2, 30 to p.3, 31); the card holder establishes the legal entity to be any one of a plurality of authorized users with authorization to make purchases using the Property Linked-credit Card, each of the authorized users establishes a unique password, and use of the Property Linked-credit Card by said any one of a plurality of authorized users is conditioned upon tendering to said merchant the unique password

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or other identifier (p.2, 13; p.6, 58-61; and p.12, 110); the legal entity is restricted to conducting transactions in a predetermined geographic region (p.2, 30 and p.3-4, 37); the legal entity is restricted to a predetermined spending limit (p.2, 30 to p.3, 31); the legal entity is restricted to a predetermined spending limit for a given transaction type (p.2, 30 to p.3, 31); the legal entity is restricted to using the Property Linked-credit Card for only a predetermined transaction type (p.2, 30 to p.3, 31); allowing verification of the possessory authority by the card bearer over the associated property as a precondition for the transaction (p.1, 7 and p.2, 13; and p.3, 31-32--may set as a parameter); receiving the goods or services in an automobile of the card bearer (p.1, 7 and p.2, 13; and p.3, 31-32--may set as a parameter); the specified property is an e-mail address and the step of establishing possessory authority comprises communicating with the merchant from the e-mail address (p.13, 119-120) a password associated with the card bearer to the merchant (p.12, 110); the password is a first password and the card bearer is a first card bearer and wherein a second card bearer has a second password for the Property Linked-Credit Card (p.12, 110—may set passwords for user and linked accounts); the card bearer is restricted to conducting transactions in a predetermined geographic region (p.2, 30 and p.3-4, 37); the card bearer is restricted to a predefined spending limit (p.2, 30 and p.3, 31); the card bearer is restricted to a predefined spending limit for a given transaction type (p.2, 30 and p.3, 31); the card bearer is restricted to conducting a given transaction type (p.2, 30 to p.3, 31); the given transaction type is an Internet transaction (p.2, 30 to p.3, 31); the given transaction type is a telephone transaction (p.13, 119-120); providing a password associated with the

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card bearer to the merchant, wherein the password is a first password and the card bearer is a first card bearer, and wherein a second card bearer has a second password for the Property Linked-Credit Card, and arranging for delivery of the goods or services of the transaction to the specified property, wherein the first password is associated with a first predetermined limitation on the first card bearer's use of the Property Linked-credit Card, and the second password is associated with a second predetermined limitation on the second card bearer's use of the Property Linked-credit Card (p.1, 7; p.2, 13; p.3, 31-32; and p.12, 110-- may set passwords and associate them with parameters and may set a parameter for the location of the delivery of goods). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate limiting the delivery of the purchase to the specified property; the card holder is a different legal entity than the card bearer; the card holder prescribes a pre-selected password to authorize a purchase using the Property Linked-credit Card; the purchase is conditioned upon the card holder presenting the vehicle for inspection and/or verification by the merchant; specifying a password or other identifier and said merchant limits the use of the Property Linked-credit Card to a legal entity that delivers to said merchant the specified password or other identifier; the card holder establishes the legal entity to be any one of a plurality of authorized users with authorization to make purchases using the Property Linked-credit Card; each of the authorized users establishes a unique password, and use of the Property Linked-credit Card by said any one of a plurality of authorized users is conditioned upon tendering to said merchant the unique password or other identifier; the legal entity is restricted to conducting

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transactions in a predetermined geographic region; the legal entity is restricted to a predetermined spending limit; the legal entity is restricted to a predetermined spending limit for a given transaction type; the legal entity is restricted to using the Property Linked-credit Card for only a predetermined transaction type; allowing verification of the possessory authority by the card bearer over the associated property as a precondition for the transaction; receiving the goods or services in an automobile of the card bearer; the specified property is an e-mail address and the step of establishing possessory authority comprises communicating with the merchant from the e-mail address a password associated with the card bearer to the merchant; the password is a first password and the card bearer is a first card bearer and wherein a second card bearer has a second password for the Property Linked-Credit Card; the card bearer is restricted to conducting transactions in a predetermined geographic region; the card bearer is restricted to a predefined spending limit; specifying a password or other identifier; the merchant limiting the use of the property-linked credit card to a legal entity that delivers to the merchant the specified password or other identifier; the card bearer is restricted to a predefined spending limit for a given transaction type; the card bearer is restricted to conducting a given transaction type; the given transaction type is an Internet transaction; the given transaction type is a telephone transaction; providing a password associated with the card bearer to the merchant, wherein the password is a first password and the card bearer is a first card bearer, and wherein a second card bearer has a second password for the Property Linked-Credit Card, and arranging for delivery of the goods or services of the transaction to the specified property, wherein the

first password is associated with a first predetermined limitation on the first card bearer's use of the Property Linked-credit Card, and the second password is associated with a second predetermined limitation on the second card bearer's use of the Property Linked-credit Card, as taught by Blagg into the invention disclosed by White, to demonstrate that the property-linked credit card may have usage parameter settings to additionally protect against unauthorized use.

Provisional Application Listed on PTO-892 form

If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a substantial delay by the Office in fulfilling the order for the copy of the provisional application. Where the applicant has been notified on the PTO-892 that a copy of the provisional application is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will be automatically furnished without charge does not apply.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


LMH